

No. 20-696

In The
Supreme Court of the United States

—————◆—————
PETER BROWNSTEIN,

Petitioner,

v.

TINA LINDSAY, et al.,

Respondents.

—————◆—————
**On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Third Circuit**

—————◆—————
BRIEF IN OPPOSITION

—————◆—————
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QUESTION PRESENTED

Whether summary judgment was appropriately granted and affirmed where Petitioner failed to provide any evidence that his post-1997 computer code was part of a product licensed by Defendants after May 2010.

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INTRODUCTION

Petitioner attempts to cast this as a dispute involving important, unresolved issues of copyright law. It is not. There are no legal questions to be resolved by this Court. Despite almost a decade of litigation in the District Court and two trips to the Circuit Court, Petitioner could not survive summary judgment for the simple reason that he was unable to marshal any evidence to support his co-authorship claim. The Third Circuit made no new pronouncements of copyright law. Rather, it affirmed that the District Court properly granted summary judgment where Petitioner failed to come forward with any evidence that the computer code that he purportedly created was being used and licensed for profit by Respondents.

The Petition presented to this Court is riddled with unsupported factual contentions, which is why there are large segments of the Petition that contain no citations to the record or decisions below. In essence, Petitioner does not present this Court with a case or controversy, but rather a hypothetical based on “facts” for which Petitioner produced no evidence. But it is not worth this Court’s attention or time to wade through the morass of new, unsupported contentions made by Petitioner here to try to resuscitate a claim that failed due to his own admitted lack of evidence. Nor is it worth this Court’s time to second guess the lower courts’ analysis of a settlement agreement. Certiorari should be denied.



STATEMENT OF THE CASE

The first line of the Petition begins with a misstatement of fact – that Petitioner is a co-author of a joint work that was “used to create a further derivative work known as the E-Tech.” (Pet. i.) That sentence represents something Petitioner tried to prove but could not. To orient this Court, Petitioner’s claim is that he is a co-author of a joint work, along with Respondent Tina Lindsay, that was licensed for profit by Lindsay without accounting to Petitioner. Respondent Ethnic Technologies, LLC (“ET”) is not an alleged co-author, so there is no scenario under which ET could be liable to Petitioner for his co-authorship claim.

Petitioner refers to the purported joint work at issue as the LCID, which ironically stands for the “*Lindsay* Cultural Identification Determinant.” No matter, the identity of the joint work changes to suit Petitioner’s ever-changing theories of liability. Petitioner has tried to create a cloud of confusion to allow him to backtrack on his positions and claims to keep this case alive for over ten years. The District Court was able to ferret out Petitioner’s contrivance. (App. 23, 26 (“Plaintiff changed course” and “Plaintiff’s newly minted theory of joint authorship”).) But Petitioner’s change of course fared no better than his original tack, as both theories are devoid of any evidential support.

The District Court found no evidence to support Petitioner’s causal leap from his purported co-ownership of the LCID (which is also disputed) to any ownership interest in the E-Tech System. (App. 27.)

Petitioner conducted no comparison or analysis of the E-Tech System (he did not even make a request to do so) by anyone, let alone an expert, who could provide the evidential link – proof of the actual use of something Petitioner authored and continued to own – required for Petitioner’s claim to have any merit. (App. 33.) Petitioner baldly contends that the E-Tech System is derived from the LCID but offers no evidence to support the contention. That is the sole reason why summary judgment was granted in favor of Respondents – no genuine issue of material fact was ever in dispute because Petitioner presented no evidence.

Yet, Petitioner paints his first Question Presented to this Court as if he has proven that he co-authored something that was later licensed for profit by Respondents. Essentially, Petitioner would like this Court to believe that he has proven his case below but was denied redress due to some legal technicality. Not so.

Petitioner’s opening sentence would be remarkable if it were not so predictable. The problem with this litigation has been and continues to be Petitioner’s confusion between a claim and proof. Petitioner claims to be the co-author of something that was later licensed for profit, but Petitioner presented the courts below with no evidence to support that claim, which is why his case was summarily dismissed. Petitioner claims that he did not give up an ownership interest in programs by virtue of a settlement agreement, but the unambiguous language of the agreement contradicts that claim. So, let us revisit what Petitioner is actually suing over and why two different district court Judges

and the Third Circuit have determined that there is insufficient evidence for that claim to survive summary judgment.

I. Factual Background

In 1993, after researching origins of first and last names for almost two years, Lindsay developed a system of rules for categorizing and predicting the ethnicity of names. (App. 38.) This system was the Ethnic Determinant System (“EDS”). (App. 38.) The EDS existed as a system “independent of any computer language or any computer.” (Lindsay Trial Tr., A-273:11-12; A-275:1-11; A-284:3-18.)¹

Lindsay and Petitioner worked together at a company called Future Prospective Clients, Inc., which would later be renamed (with the same principals) as List Services Direct, Inc. (“LSDI”) (App. 37-38.) LSDI learned of Lindsay’s EDS and tasked Petitioner with translating the EDS into computer code. (App. 38.) The EDS, as translated into computer code, was a product called the Lindsay Cultural Identification Determinant or “LCID” which could only run in the now obsolete COBOL programming language used on certain mainframe computers with certain operating systems. (Pl. Trial Tr., SA-182 at 2-12.) The computer code alone (as differentiated from the combined EDS and code,

¹ “A” shall refer to citations to Appellant’s Appendix. “SA” shall refer to citations to the Appellees’ Supplemental Appendix. “App.” shall refer to citations to Petitioner’s Appendix.

i.e., the LCID), was known as the “ETHN” or the “ETHN programs.” (App. 38.)

As the Third Circuit previously determined in *Brownstein v. Lindsay*, 742 F.3d 55, 59 (3d Cir. 2014) (“*Brownstein I*”) (App. 35), Lindsay is the sole owner of the EDS and she alone has the exclusive right to create derivative works of the EDS. (App. 38.) The Third Circuit additionally held that the LCID and EDS are “distinct works with distinct copyrights.” (App. 55.)

LSDI began marketing the LCID as its own product to LSDI’s own clients, often referring to the LCID as the “LSDI Program.” (LSDI Marketing Brochure, SA-247-51.) An LSDI form licensing agreement shows how LSDI was referring to and trying to license the LCID in May 1997. (LSDI Form Agreement, A-300.) Lindsay recognized that LSDI would claim that the EDS was owned by LSDI, so she took steps to protect her work and filed two applications to register the copyright in her EDS in February and December 1996, respectively. (App. 39.)

Around that time, Lindsay and Petitioner began discussing the formation of a separate company to utilize and profit from the EDS, as well as other list industry initiatives. To that end, they formed TAP Systems, Inc. (“TAP”) in June 1996. (App. 39.) They were equal partners in TAP but continued to work at LSDI. Lindsay, who always intended and considered herself to be the sole and exclusive owner of the EDS and all computer translations of the EDS, including

the LCID, licensed the LCID product to TAP, so TAP could license it to customers. (App. 41.)

LSDI sued Petitioner, Lindsay, and TAP over the LCID, claiming that it was created as a work for hire. (App. 43.)

In September 1997, while the LSDI litigation was ongoing, TAP combined its assets with Consumers Marketing Research, Inc. (“CMR”), and formed a new company, named Ethnic Technologies, LLC or “ET”. (App. 41.) The LSDI lawsuit settled. As a result, as mandated by the plain language of the settlement agreement and as determined by the Third Circuit, Lindsay retained sole ownership over the EDS, but Lindsay and Petitioner gave up any interest in the programs that Petitioner had created while employed at LSDI, which included the ETHN programs. (App. 4, 29-30.)

As the Third Circuit did in *Brownstein I*, the parties to the LSDI settlement, including Petitioner himself, differentiated between the EDS and computer programs derived from the EDS. Again, as set forth in the plain language of the Settlement Agreement and as determined by the Third Circuit, both Petitioner and Lindsay gave up ownership interest in the programs Petitioner created while employed at LSDI. Since those programs combined with the EDS constituted the LCID, both Lindsay and Petitioner gave up ownership of the LCID, as it was constituted prior to the 1998 settlement agreement. (App. 6.)

II. Procedural History

A. Petitioner Claims to be a Co-Author of the EDS

While being handsomely paid in a buyout of his interest in ET around 2010 (A-240), in parallel, and almost 15 years after Petitioner learned that Lindsay had copyrighted the EDS, Petitioner began this lawsuit by alleging that he was the “co-author of a joint work for which defendant Tina Lindsay registered a copyright in 1996.” As part of this process, Petitioner filed a number of copyright registrations claiming *sole* ownership over Lindsay’s 1996 copyrighted work (*see* A-87, A-90), without Lindsay’s permission. (App. 11-12.) Almost two years after initially filing this lawsuit, Petitioner amended his Complaint, but continued to allege that he was “the co-author of a joint work for which Tina Lindsay registered *two* copyrights in 1996.” (FAC, A-99.) The only work copyrighted by Lindsay in 1996 was called the “EDS”. (App. 12.)

The EDS belongs solely to Lindsay, as determined by the Third Circuit in *Brownstein I* (not the subject of this Petition). (App. 38.) So, in the first two iterations of his lawsuit, Petitioner claimed to be the co-author of the EDS, which was the 1996 copyrighted work that the Third Circuit later held (1) belonged solely to Lindsay and (2) was distinct from the LCID, with separate and distinct copyrights. Petitioner proceeded to trial on that claim, but it was dismissed as a matter of law under FED. R. CIV. P. 50 before Respondents put on their defense. (App. 18.) During the first trial and in the first

appeal, Petitioner never raised the issue that the LSDI settlement agreement was defective under 17 U.S.C. § 204 – the Copyright Act’s “statute of frauds.”

B. *Brownstein I*

On the first appeal (*Brownstein I*), the Third Circuit held that the EDS was the sole property of Lindsay. (App. 38-39.) That should have resolved this dispute, but the Third Circuit remanded the case to allow Petitioner to attempt to show that his purported programs (the ETHN programs) were used in software licensed by Lindsay after 1997. (App. 21.) The reason the programs had to be post-1997 was because Petitioner gave up any interest in the ETHN programs, as they existed at the time, in the LSDI Settlement Agreement. (App. 21.)

The decision in *Brownstein I* laid out a clear roadmap for the District Court to follow on remand:

- 1) “Lindsay was the sole author of the EDS.” (App. 38.)
- 2) The LCID and the EDS “are distinct works with distinct copyrights.” (App. 55.)
- 3) Brownstein retained rights only to those “subsequent generations of ETHN programs that Brownstein developed after the 1998 Settlement Agreement” – if any. (App. 58.)

4) “[T]he 1998 LSDI Settlement Agreement [signed by Petitioner] abrogated [Petitioner’s] ownership of the pre-1998 generations of the ETHN programs.” (App. 62.)

5) “Brownstein retains an interest in the post-1997 versions of the LCID insofar as they are based on any version of the LCID to which he is co-author.” (App. 58.)

6) “Brownstein . . . has never claimed authorship of, [sic] the E-Tech system.” (App. 75.)²

Leaving aside Respondents’ statute of limitations defense,³ the only remaining question to be answered on remand was whether Respondents’ programs utilized Petitioner’s code without compensating him. (App. 58 (***“It is possible that the post-1997 versions of the LCID continued to employ the code created by Brownstein, but such determination would***

² Remarkably, in *Brownstein I*, the Third Circuit noted that Petitioner was *not* seeking a declaration of co-ownership over the E-Tech System, yet in the first line of this Petition he claims ownership over the E-Tech System, as a derivative of his purported joint work. (App. 75.)

³ Petitioner claims that Respondents “pivoted away from the statutes [sic] of limitations defense” on remand. (Pet. 3.) Petitioner misunderstands the procedural posture of the case on remand. Petitioner’s claim was dismissed on summary judgment due a lack of evidence to support Petitioner’s claim. Had Petitioner survived summary judgment and the case proceeded to trial, Respondents would have put on their defense based upon, *inter alia*, the statute of limitations, work for hire and other defenses, but this case has never reached that point due to Petitioner’s failure of proof.

require additional factual development at trial.
(emphasis added)).)

C. Petitioner Fails to Follow the Mandate from *Brownstein I*

Following remand from *Brownstein I*, this case was assigned to a different district court Judge. The Judge recognized that Petitioner’s operative complaint (the First Amended Complaint) sought a declaration of co-authorship over the EDS, but such a declaration was at odds with the evidence and the opinion in *Brownstein I*. (App. 22.)

Specifically, the Third Circuit had determined that Lindsay was the sole author and owner of the copyright in the EDS and all derivatives therefrom. (App. 38.) Because Petitioner has no claim of co-authorship over the EDS, his operative pleading was defective. (App. 22.) Therefore, “[a]fter remand, [the District Court] directed Plaintiff to amend his complaint consistent with the undisputed facts that were determined during the first trial, which were recounted by the circuit court in its published decision.” (App. 11, 23.)

As directed by *Brownstein I*, on remand Petitioner was required to show that computer code he purportedly created continued to be used in post-1997 versions of the LCID. ***“It is possible that the post-1997 versions of the LCID continued to employ the code created by Brownstein, but such determination would require additional factual development at trial.”*** (App. 58 (emphasis added).) In short, Petitioner

had the burden to show that Respondents were using, or in fact had ever used, “*his*” computer code.

Petitioner also had the burden of showing that his computer code was licensed by Lindsay for profit *after* May 2010 because, prior to that date, Petitioner and Lindsay had shared equally in all profits. (App. 27.) A co-owner must account for the other’s “fair share of profits from any non-exclusive license.” (App. 60.) Petitioner was ousted from ET, and his ownership interest was bought out on May 25, 2010. (App. 17.) Thus, Petitioner’s only claim is for his “fair share” of profits from any non-exclusive licenses granted by Lindsay after his buyout.⁴

In the Third Amended Complaint (TAC, A-227),⁵ Petitioner not only failed to allege that Lindsay continued to license a product containing Petitioner’s code after May 2010, but Petitioner also admitted that in “mid-2010” the relevant product (the E-Tech System) “phased out the versions of the E-Tech created for use on mainframes, which incorporated the original computer programming of the LCID.” (App. 7; TAC, A-231 at ¶26.) This was a damning admission, as Petitioner’s entire claim rested on his showing that his programs were part of the E-Tech System, but Plaintiff

⁴ The statute of limitations defense compels Petitioner to take this position because if he claims he was not receiving his fair share from the licensing agreements that he signed from 2000 to 2005, then it would have been an express repudiation of his interest and the statute of limitations would bar his claim.

⁵ The “Second” Amended Complaint was stricken from the docket. (A-225-226.)

“programmed in a language called COBOL” which was only used in the mainframe computer environment. (Pl. Dec. at ¶18, A-442E.) In other words, Petitioner admitted that, by mid-2010, the E-Tech System used none of Petitioner’s computer code. This concession was a significant one for the Third Circuit in *Brownstein v. Lindsay*, 812 Fed. Appx. 75, 78 (3d Cir. 2020) (*reh’g denied*) (“*Brownstein II*”). (App. 7.)

Petitioner knew that he could not prove the case that he was required to prove, so he tried to invent a new one. Instead of amending his pleading to conform to this Court’s decision in *Brownstein I*, Petitioner offered what the District Court called another “newly minted theory of joint authorship.” (App. 26.) Petitioner’s new theory was that the E-Tech System licensed by ET after May 2010 is a derivative of the LCID and, as a co-author in the LCID, he is a co-owner of all derivatives. (App. 27.) This was indeed an entirely new theory – one which was supported by absolutely **no** evidence.

But while Petitioner has no problem proclaiming that the E-Tech System is derived from the LCID; he never bothered to offer any evidence to support that contention. This was fatal to Petitioner’s case, as the District Court rightly decided that Petitioner “has not carried his burden of proving that he is a co-author of the later version of the LCID that was licensed to TAP or ET *after* the 1998 LSDI Settlement Agreement.” (App. 27.) The District Court thoroughly rebuked Petitioner’s baseless argument (the same one he makes here), that despite the Third Circuit remanding the case to be tried to a jury, “he has no obligation to prove

that his code survives to this day.” (App. 28.) Ultimately, the District Court held that Petitioner’s attempted change of course was unsuccessful.

[T]o survive summary judgment, Petitioner must present some evidence to show that E-Tech or the LCID, in their later versions, contained his work. Petitioner has failed to [do] so. After years of discovery, numerous rounds of motion practice, and a trial, Petitioner still has not adduced any cogent evidence to establish that he is a co-author of any versions of the LCID, and in turn E-Tech, after the 1998 LSDI settlement.

(App. 31.)

Accordingly, the District Court rightly held that Petitioner had the burden of coming forward with evidence that Respondents used his actual code. (App. 21.) (“while it is possible that the later versions of the LCID continued to employ the code created by Brownstein, it is incumbent upon him to make that evidentiary showing.”). The District Court rejected Petitioner’s “simplistic view of the facts,” in which he repeats over and over, as if a mantra, that he is a co-author of the LCID, without offering any evidence that Defendants continued post-1997 to use code that he created. (App. 27.)

D. *Brownstein II* Affirms the Grant of Summary Judgment

The only decision that Petitioner is asking this Court to review is the Third Circuit’s affirmance of the

grant of summary judgment in *Brownstein II*. (App. 1.) In *Brownstein II*, the Third Circuit affirmed the District Court’s grant of summary judgment. In so doing, *Brownstein II* rejected Petitioner’s argument that the District Court erred in finding that both Petitioner and Lindsay abrogated their rights to the LCID in the 1998 settlement agreement. (App. 6.) The Court relied upon *Greene v. Ablon*, 794 F.3d 133, 155 (1st Cir. 2015) for the proposition that a work can be both joint (the LCID) and derivative of an original work (the EDS), which is owned by a single author (Lindsay). (App. 6.) The Petition makes no mention of *Greene*, and thus offers no legal criticism of the *Brownstein II* Court’s conclusion.

Brownstein II also rejected Petitioner’s argument that the District Court misread the 1998 Settlement Agreement by pointing out that Petitioner was “ignor[ing] language in the Settlement Agreement . . .” (App. 6.) Hardly a compelling justification for this Court to grant certiorari. Importantly for this Petition, Petitioner below argued only that the interpretation of the Settlement Agreement was erroneous. He did not argue that the Settlement Agreement was defective under 17 U.S.C. § 204.

Finally, *Brownstein II* affirmed the District Court’s finding that Petitioner “failed to demonstrate that Lindsay and E-Tech profited from [a post-Settlement Agreement version of the LCID], or a derivative thereof, in May 2010 or afterward.” (App. 7.)

The decision in *Brownstein II* did not hinge on a new question of federal law, nor did it reveal a split amongst any of the Circuits. The decision was a straightforward review of a trial court's grant of summary judgment due to a "failure of proof." *Katz v. Aetna Cas. & Sur. Co.*, 972 F.2d 53, 55 (3d Cir. 1992) (quoting *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986)). And that failure was not for want of trying. When asked at the close of oral argument of *Brownstein II* if discovery in the case was over, Petitioner's counsel, without hesitation, agreed that it was. Nonetheless, Petitioner seems to blame Respondents and the lower courts for his own inability to prove his case. "[T]he holdings of the District Court and the *Brownstein II* court begs the question of what exactly it was that ET sold after the settlement agreement was executed." (Pet. 26.) Indeed. Perhaps Petitioner should have used the past ten years to figure that out. Had he, then he would have discovered that none of Petitioner's programs were ever sold.

III. Petitioner's Misstatements and Omissions of Facts

Petitioner continues to conflate his purported co-authorship of the LCID with his claim that he is entitled to royalties from the licensing of the E-Tech System. To put it another way – Petitioner may be able to prove that he is co-author of a thing called the LCID (though that remains in dispute), but so what? If the LCID is not the progenitor of, or even a part of, the E-Tech System, then Petitioner has no claim. Petitioner recognizes this glaring gap in proof, which is why he

misrepresents to this Court that the “E-Tech in its multiple iterations is indisputably a derivative work.” (Pet. 20.) False. Petitioner also claims that he “created the first working version of the combined product, known as the E-Tech, in January 1998.” (Pet. 7.) Again, false. Petitioner also claims that the Circuit Court in *Brownstein II* erred by holding that Petitioner, “but somehow not Lindsay” had forfeited his ownership in the product that was licensed to E-Tech in 1997 and 2000. (Pet. 24.) Also false. *Brownstein II* affirmed the District Court’s finding that *both* Lindsay and Petitioner forfeited their rights to the LCID by virtue of the 1998 settlement agreement. (App. 6.)

Petitioner also attempts to conflate the LCID with the TAP System. (Pet. 25 (“the LCID and its iteration the TAP System”).) The TAP System was not the LCID, nor was it a derivative of it, and neither is E-Tech. The Third Circuit made no such finding. Indeed, Petitioner’s conflation is designed to obscure his lack of evidence. The TAP System required different computer programs than the earlier LCID, as did E-Tech. Petitioner pulls from contracts the phrase “irrevocably entwined” claiming, without evidence, that the LCID is the original copyright. It is not.

This argument fails for a number of reasons. “Irrevocably entwined” in context was used solely to warn and prevent licensees from decomposing or reverse engineering ET products. Thus, the simple but incorrect assumption that one co-author “wrote the song and the other wrote the lyrics” does not fit with the facts of this case. The fact that Tina Lindsay’s original EDS

copyright has been implemented with (1) independently written mainframe programs (LCID and others) and (2) ET server and desktop programs to create different products, clearly shows that EDS is not irrevocably entwined from a copyright perspective with any computer programs.

Later, Petitioner misrepresents that “Defendants did not dispute on summary judgment that all versions from the E-Tech’s initial iteration through the present are derived in some part from the initial LCID System.” (Pet. 24.) False. At the District Court and the Third Circuit, Respondents absolutely disputed that “fact” and did so in their own statement of undisputed facts submitted in support of summary judgment: “Following the 1998 LSDI settlement agreement, the EDS could no longer utilize the programs created by Petitioner at LSDI, so the ‘LCID’ as originally constituted no longer existed.” (A-257 at ¶15; Appellees’ Br. at 35.) That is *the* dispute.

Assuming, *arguendo*, Petitioner is a co-author of the LCID, he must still show that Lindsay licensed a product containing Petitioner’s coding or its derivatives for profit, after May 2010. Instead of attempting to show that is the case, Petitioner argues that he can simply proclaim that the product licensed by ET through Lindsay (the E-Tech System) is a derivative of the LCID. There is no evidence to support Petitioner’s proclamation. And that proclamation is also contrary to Petitioner’s professed claims to the Third Circuit in *Brownstein I*, which noted that Petitioner “has never claimed authorship of, the E-Tech System.” (App. 75.)

Six years and a second appeal later and Petitioner is telling the Supreme Court of the United States that he is the owner of the E-Tech System. Patently, false.

Petitioner's absence of evidence, however, cannot be laid at the feet of Respondents. As the District Court pointed out, it is not Respondents' burden to show that Petitioner's purported code or derivatives therefrom are not in their licensed product; it is Petitioner's burden to prove that Respondents used the code. (App. 32.) Petitioner failed to carry that burden, since there was no evidence. (App. 34.) For that simple reason, Petitioner's claim failed to survive summary judgment.



REASONS TO DENY THE PETITION

I. The Petition Does Not Involve Unresolved Questions of Federal Law or a Dispute Amongst the Lower Circuit Courts Regarding the Rights of a Co-Author

Petitioner identifies two reasons that this Court should grant certiorari. Neither is compelling. The first reason appears to be Petitioner's belief that the lower courts misapplied the facts of his case to the applicable law. Even, assuming that this were accurate (it is not), this is not a sufficient basis for this Court's review. As demonstrated in the factual and procedural background above, Petitioner's co-authorship claim is an inherently fact-based determination based on the very particular circumstances of his claim. The

architecture⁶ of the Petition itself demonstrates that Petitioner’s qualm is not of a legal nature rather it is based on his disagreement with the lower courts’ interpretation and analysis of the facts of this case. Petitioner’s claim was summarily dismissed because he failed to offer any evidence to support the claim, not because the Third Circuit misstated the law under the Copyright Act.

Nonetheless, to tempt this Court into granting certiorari, Petitioner half-heartedly claims that *Brownstein II* was in conflict with *Brownstein I*,⁷ the Ninth and Second Circuits. (Pet. 27.) To reach his conclusion, Petitioner simply regurgitates the well-settled law that a co-owner of a copyright must account to other co-owners for any profits gained from the licensing of the copyright. (See Pet. 25.) That recitation of basic copyright law is a correct one, and *Brownstein II* applied the same law. In fact, *Brownstein II* specifically quoted that legal maxim from the same treatise to which Petitioner cites this Court – *Nimmer on Copyright* (2019). (App. 5.) There is no disagreement with that statement of the law; there is thus, no split amongst the Circuits.

⁶ Petitioner begins by summarizing the “joint works and joint authors” under the Copyright Act. (Pet. 17-18.) He then identifies the purported copyrighted work at issue here. (Pet. 20.) And he concludes with his analysis of the facts of his case to the law.

⁷ Notably, the author of *Brownstein I* disagrees with Petitioner, as Judge Greenaway, Jr. was both the author of *Brownstein I* and part of the *en banc* panel that denied Petitioners request for a rehearing in *Brownstein II*. (App. 82.)

This reveals the Petition as nothing more than a thinly veiled request for reconsideration. While Petitioner dramatizes his claim as invoking significant areas of copyright law that have yet to be addressed by this Court, the reality is more mundane. Petitioner provides a book report on the tenets of joint works under the Copyright Act. (Pet. 17-18.) But there was no legal question before the lower courts regarding the definition of a joint work or the rights of co-authors to a joint work. That is where Petitioner's case has continually run aground.

Petitioner has persistently contended (to no avail) that the only thing required of him is to show that he is the co-author of a joint work – in this case the LCID. That is, however, only part of his claim. As mandated by the Third Circuit, Petitioner's claim required that he provide evidence that the joint work was part of the software that was being licensed for profit by Respondents after May 2010. (App. 6-7, 27.) Petitioner could not carry that burden. In fact, Petitioner stated in court on the record that there were likely no or minimal profits that he could claim, and he was, instead, only interested in the "attorneys[]" fees." (SA-281.) And that is where his claim failed because there is no evidence to show any linkage between the E-Tech System and the LCID that Petitioner claims to have co-authored. The E-Tech System is not a derivative work of the LCID. That lack of evidence showing the linkage between the purported joint work and the currently licensed software was fatal to Petitioner's claim. This was a case

about factual proof (or lack thereof), not any unresolved question of law.

II. The Standards for Valid Assignments of Copyright Are Well Settled and There is No Split Among the Circuit Courts on the Issue

In an effort to pique this Court's interest and entice it to grant his petition for certiorari, Petitioner suggests that the elements of valid assignments of copyrights are somehow unclear and that there exists a split among the circuit courts as to such standards. Petitioner is incorrect on both accounts. The elements of a valid assignment are very clear, and while the various circuit courts may use slightly different language in describing the standards, the standards are nonetheless consistent. Even assuming Petitioner is correct (he is not), he cannot raise these issues now because he failed to raise them below.

A. Petitioner Forfeited His Arguments with Respect to the Law of Copyright Assignment by Failing to Raise Them Below

Petitioner's conclusions about the state of the law regarding valid copyright assignments are not his only errors on the subject. More fundamentally, Petitioner suggests that it is the Third Circuit's decision in *Brownstein II* that is somehow in conflict with the decisions of other circuits. (Pet. 29 ("The *Brownstein II*

decision is in conflict with the decisions of other circuits.”.) Conspicuously missing from Petitioner’s argument, however, is a statement of the standard allegedly used by the Third Circuit in *Brownstein II*. The reason for this is simple – the *Brownstein II* standard is missing from the Petition because *Brownstein II* contains no such statement of any assignment standard. And that is because Petitioner never attributed any error to the District Court’s articulation of the law.

It is for that reason that the Third Circuit’s decision in *Brownstein II* simply summarized Petitioner’s factual arguments made on appeal: “Brownstein raises three issues on appeal. . . . Second, Brownstein argues that the Settlement Agreement did not transfer any copyrights, but merely evidenced the parties’ decision to ‘waive[] any rights of enforcement they might have had’ against the other. (Opening Br. at 43.)” (App. 6.)

The court in *Brownstein II* addresses those factual arguments by examining only the facts. Specifically, by examining the Settlement Agreement itself, without any discussion of the controlling law. That examination resulted in the Third Circuit disagreeing with Petitioner’s interpretation of the Settlement Agreement. (App. 6 (“But this argument ignores language in the Settlement Agreement . . .”).)

Thus, the Third Circuit’s decision in *Brownstein II* addressed only the facts, as that was Petitioner’s only quibble with the decision by the District Court. Petitioner never alleged that there was any dispute as to the correct legal standard, nor did Petitioner request a clarification or change to the controlling law. Those issues were never raised before the Third Circuit.

Petitioner’s Opening Brief confirms that no such legal issues were ever raised. In his Opening Brief to the Third Circuit, Petitioner argued only that the Third Circuit’s application of the particular facts of this case – specifically, the language of the Settlement Agreement – was erroneous. In other words, Petitioner argued only that the lower courts did not properly interpret or construe the Settlement Agreement. Petitioner never argued to the Third Circuit that the trial court (or the Third Circuit in *Brownstein I*) used an incorrect legal standard or that the controlling legal standard should be changed.

For example, Petitioner titled his argument to the Third Circuit in *Brownstein II* “The Court Erred in Construing the Settlement Agreement with LSDI as an Assignment of Copyright.” (Opening Brief at 4.) The entirety of Petitioner’s argument relates to the interpretation of the Settlement Agreement, not to any alleged use of an incorrect standard or for a change to the law.⁸ In fact, a review of the entirety of Petitioner’s

⁸ See, e.g., Opening Brief at 40 (“This construction of the contract was erroneous. As an initial matter, the agreement did not on its face purport to convey any exclusive rights.”); Opening Brief at 41 (“The trial court’s construction of the agreement was also in

argument below (Opening Brief at 40-43) reveals that Petitioner never once set forth what he believes the correct Third Circuit legal standard to be, never once argued that the trial court used the wrong legal standard, and never once suggested that the Third Circuit's legal standard should be changed or that there is a split among the Circuit Courts as to the correct standard.

Moreover, Petitioner never even set forth what standard the trial court purportedly used and never explained how the standard was allegedly incorrect. Indeed, there is not a single legal citation relating to the Third Circuit's, or any circuit's, standard for assessing the validity of a copyright assignment under 17 U.S.C. § 204. Petitioner's argument is devoid of any legal standards or citations, save for a single reference to a "canon of contract" interpretation.

The fact that Petitioner failed to raise the § 204 argument before the Third Circuit is not surprising, as Petitioner did not raise the issue at the trial court level. After remand and before the District Court's grant of Respondents' motion for summary judgment, the parties began their trial preparation. These preparations included Petitioner's filing of a Trial Memorandum of Law. (District Court ECF No. 168.) While Petitioner's Trial Memorandum does address the interpretation of the Settlement Agreement, it never

error insofar as it read the language of the agreement as applying to Brownstein only . . . "); and Opening Brief at 43 ("The trial court in construing the agreement to affect a transfer . . .").

mentions 17 U.S.C. § 204 and never addresses the standards required to satisfy the “writing” requirement of the statute. Similarly, Petitioner failed to raise the § 204 issue in his Brief in Opposition to Defendants’ Motion for Summary Judgement. (District Court ECF No. 193.) Petitioner did not raise the issue, in the first appeal, at the trial court post-remand, or before the Third Circuit in the second appeal. In other words, this Petition for certiorari is the very first time that Petitioner has raised the § 204 issue.

Petitioner’s failure to raise these arguments below means that he has forfeited his right to do so now. Because Petitioner failed to assert that the Third Circuit or the trial court applied an incorrect legal standard with respect to 17 U.S.C. § 204 or to argue for a change in Third Circuit law, Petitioner forfeited the right to raise these issues for the first time by way of petition to this Court. *E.g.*, *Singleton v. Wulff*, 428 U.S. 106, 120 (1976).

III. The Circuit Courts Agree as to the Controlling Standards for a Valid Copyright Assignment

Assuming, *arguendo*, that Petitioner did not forfeit the right to argue that the trial court or Third Circuit used an incorrect legal standard, or to argue that there is a split among the Circuit Courts as to the correct legal standard, Petitioner’s arguments also fail on the merits. As noted above, the Third Circuit did not set forth any controlling legal standard in *Brownstein II*.

Rather, the Third Circuit was merely opining on the propriety of the trial court's grant of Respondents' motion for summary judgment following *Brownstein I*. Similarly, the trial court on remand did not use the incorrect legal standard. Rather, the trial court merely applied the holding of *Brownstein I*, in which the Third Circuit has determined that the Settlement Agreement effected an assignment of Petitioner's rights. Thus, if there was an error as to the correct legal standard to use (there was none), it must have been committed by the Third Circuit in *Brownstein I*.

In *Brownstein I*, the Third Circuit reviewed a series of license and settlement agreements. The Third Circuit set out the law with respect to the licensing of a joint work and the rights of co-authors. With respect to the settlement agreements and whether or not any of them effected a transfer of ownership of any party's rights, the Third Circuit in *Brownstein I* held:

With respect to transferring the ownership of a joint work, a co-author cannot transfer the ownership interest of his co-author. The Copyright Act's "statute of frauds" requires that any transfer of an ownership interest must be signed and in writing. 17 U.S.C. § 204(a); see *Barefoot Architect, Inc. v. Bunge*, 632 F.3d 822, 827, 54 V.I. 948 (3d Cir. 2011).

(App. 61.)

The Third Circuit correctly identified the controlling statutory provision and correctly identified one of its own leading cases addressing the provisions of the

statute. *Barefoot Architect* was and remains valid law and has been cited by the Third Circuit as recently as 2019. As the Third Circuit recently explained, in precedential decision that repeatedly cited *Brownstein I* and further relied on *Barefoot Architect*:

Assignment. The validity and import of an assignment generally is governed by state contract law. *See Roger Miller Music, Inc. v. Sony/ATV Publ'g, LLC*, 477 F.3d 383, 392 (6th Cir. 2007); *Walthal v. Rusk*, 172 F.3d 481, 485 (7th Cir. 1999). The Copyright Act merely adds that an assignment must be memorialized by an “instrument of conveyance, or a note or memorandum of the transfer, . . . in writing and signed by the owner of the rights conveyed or such owner’s duly authorized agent.” 17 U.S.C. § 204(a); *see Barefoot Architect, Inc. v. Bunge*, 632 F.3d 822, 827 (3d Cir. 2011).

TD Bank N.A. v. Hill, 928 F.3d 259, 273-74 (3d Cir. 2019).

In explaining and applying New York law to the contract at issue, the Third Circuit in *TD Bank* held:

Under that state’s law, courts construe assignments using the ‘same rules which obtain in the interpretation of other contracts,’ *Crook v. Rindskopf*, 12 N.E. 174, 177 (N.Y. 1887), which include giving effect to the parties’ intent as principally expressed through the words of the agreement itself, *Greenfield v. Philles Records, Inc.*, 780 N.E.2d 166, 170 (N.Y. 2002).

TD Bank, 928 F.3d at 274. Perhaps most importantly for the instant Petition, the Third Circuit held that the

“agreement need not comply with any formalities or invoke particular language to constitute” an assignment.” *Id.*

In just a single paragraph, without a single quote from any of the implicated cases, Petitioner argues that this Third Circuit law is in conflict with decisions of the Fifth and Seventh Circuits. Petitioner, however, does not clearly explain what standards he alleges the Third Circuit to have applied or the standards of the Fifth and Seventh Circuits.

For example, Petitioner seems to be arguing (though it is somewhat unclear) that the language of § 204 requires the use of specific language in any agreement that purports to assign a copyright. (Pet. 29.) (“Conspicuously absent from the agreement is any language that purports to be an ‘instrument of conveyance’ or ‘note or memorandum’ of the transfer.”) As noted above, however, Third Circuit law does not require a § 204-compliant assignment to “invoke particular language.” And the Third Circuit is not in conflict with any other circuit in this regard.

The Fifth Circuit decision upon which Petitioner relies, *In re Isbell Records, Inc.*, 586 F.3d 334 (5th Cir. 2009), contains no detailed analysis of 17 U.S.C. § 204. In fact, *In re Isbell Records, Inc.* never references § 204. Rather, the Fifth Circuit starts with the presumption that copyright assignments are treated in exactly the same way as all other contracts, examining only whether the assignment contract at issue was ambiguous. *Id.* at 337 (“When construing a contract, the

court's goal is to give effect to the intentions of the parties."'). There is absolutely no discussion of § 204's requirements. The discussion of the rules of contract interpretation, however, is completely consistent with the Third Circuit's approach.

Other cases from within the Fifth Circuit that specifically address the requirements of 17 U.S.C. § 204 are also consistent with the Third Circuit's approach. As the Fifth Circuit explained in *Lyrick Studios, Inc. v. Big Idea Productions, Inc.*, 420 F.3d 388, 392 (5th Cir. 2005):

The writing in question 'doesn't have to be the Magna Carta; a one-line pro forma statement will do.' *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990). Nor does the writing have to contain any particular language. *Radio Television Espanola S.A. v. New World Entm't, Ltd.*, 183 F.3d 922, 927 (9th Cir. 1999) ('No magic words must be included in a document to satisfy § 204(a).').

Thus, both the Third and the Fifth Circuit rely on basic contract law provisions to interpret assignments, and both Courts have held that assignments need not contain any "particular language" to comply with § 204.

With respect to the Seventh Circuit, as shown above, in its 2019 *TD Bank* decision, the Third Circuit cited and relied upon the Seventh Circuit's *Walthal v. Rusk* decision on this exact issue, indicating that the two Circuits (the Third and Seventh) are not in conflict.

TD Bank, F.3d at 273-74. In *Walthal*, the Seventh Circuit held: “In general, state contract laws pertain to the transfer of interests under the Copyright Act.” *Id.* at 485.

The Seventh Circuit case cited by Petitioner, *HyperQuest, Inc. v. N’Site Sols., Inc.*, 632 F.3d 377, 383 (7th Cir. 2011), does not hold to the contrary. *HyperQuest* did not address the standard of § 204 assignments. Rather, *HyperQuest* dealt with whether or not the agreement at issue – a purported “exclusive license” – transferred sufficient rights to permit a suit for infringement. Though tangentially related to the issue raised by Petitioner, the issue in *HyperQuest* – what rights must be assigned to give an assignee the right to sue – is distinct, and each has their own body of case law.

To the extent, *HyperQuest* is relevant, it is entirely consistent with, and relies upon, *In re Isbell Records, Inc.* This approach is consistent with other cases from the Seventh Circuit. *E.g.*, *Schiller Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 413 (7th Cir. 1992) (“Although the agreement does not mention the word ‘copyright,’ its wording leaves little doubt that Bertel sold all the assets of Spotline Studios, tangible and intangible alike. . . . It is true that the Copyright Act requires that assignments be in writing, 17 U.S.C. § 204, but we have the writing (the sale agreement between Bertel and Ojenus); the issue is its interpretation.”).

This contract-based approach, without the need for a copyright assignment to contain any “magic words” to satisfy § 204’s writing requirement, is applied consistently among the federal circuits and espoused by the leading copyright commentator.⁹

The Third, Fifth, and Seventh Circuits and, indeed, all the Circuits, agree as to the requirements under § 204. While a writing is required, the sufficiency

⁹ *E.g.*, *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990) (to satisfy § 204, the writing “doesn’t have to be the Magna Charta; a one-line pro forma statement will do.”); *Radio Television Espanola S.A. v. New World Entm’t, Ltd.*, 183 F.3d 922, 927 (9th Cir. 1999) (“**No magic words must be included in a document to satisfy § 204(a),**” (emphasis added) (*citing, inter alia*, 3 Melville B. Nimmer David Nimmer, *Nimmer on Copyright*, § 10.03[A][2] at 10-37); *Small Justice LLC v. Xcentric Ventures LLC*, 99 F. Supp. 3d 190, 194 (D. Mass. 2015), *amended*, No. 13-CV-11701, 2015 WL 5737135 (D. Mass. Sept. 30, 2015), and *aff’d*, 873 F.3d 313 (1st Cir. 2017) (“Copyright transfer requires only a simple writing signed by the copyright owner”); *Jasper v. Bovina Music*, 314 F.3d 42, 47 (2d Cir. 2002) (“[t]he need for interpretation of a contract does not necessarily mean that there is a bona fide issue as to whether the contract is a writing for purposes of section 204(a)”; *Metro. Reg’l Info. Sys., Inc. v. Am. Home Realty Network, Inc.*, 722 F.3d 591, 600 (4th Cir. 2013) (“magic words” not required); *Thomsen v. Famous Dave’s of Am., Inc.*, 606 F.3d 905, 908 (8th Cir. 2010) (“magic words” not required); *Roger Miller Music, Inc. v. Sony/ATV Publishing, LLC*, 477 F.3d 383 (6th Cir. 2007) (“Nevertheless, ‘[s]o long as the parties’ intent is clear, a transfer of copyright need not include any particular language.’”); *Johnson v. Storix, Inc.*, 716 Fed. Appx. 628, 630 (9th Cir. 2017) (“magic words” not required); *SCO Grp., Inc. v. Novell, Inc.*, 578 F.3d 1201, 1212 (10th Cir. 2009) (“Section 204(a), by its terms, imposes only the requirement that a copyright transfer be in writing and signed by the parties from whom the copyright is transferred; it does not on its face impose any heightened burden of clarity or particularity.”).

of the writing is guided by ordinary principles of contract law. The statute's references to "an instrument of conveyance, or a note or memorandum of the transfer" does not require any particular or magic words.

Petitioner's actual complaint is not with the law applied by the Third Circuit, but with its conclusion, *i.e.*, its specific contract interpretation. The Settlement Agreement is a written agreement, signed by Petitioner. There is no bona fide issue that the Settlement Agreement satisfies § 204. The Third Circuit interpreted the Settlement Agreement against Petitioner's interests. In this regard, the issue is akin to the one presented to the Second Circuit in *Jasper*, *supra*, where the court explained that simply because a contract must be interpreted, it does not "necessarily mean that there is a bona fide issue as to whether the contract is a writing for purposes of section 204(a)." *Jasper*, 314 F.3d at 47.

In short, where, as here, there is no doubt that the Settlement Agreement is a § 204(a) writing, the only question was one of interpretation. In *Brownstein II*, the Third Circuit held that the Settlement Agreement did act as a transfer of Petitioner's rights. While Petitioner may disagree with the lower courts' interpretation of the Settlement Agreement, that disagreement over contract interpretation is not an issue appropriate for this Court's review.



CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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